

Appl. No. 09/827,192  
Amdt. Dated October 6, 2003  
Reply of Office action of June 4, 2003

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**Remarks**

Claims 1-35 are pending in the instant application. Claims 19 – 35 have been withdrawn. Accordingly, claims 1 - 18 form the subject matter of the response. Based on the remarks made herein, Applicants respectfully request that the rejections be withdrawn and that the application be passed to allowance.

**Election/Restriction**

Applicants hereby affirm the provisional election made on May 27, 2003, to prosecute the invention of Group I, claims 1 - 18. Applicants specifically reserve the right to seek patent protection for non-elected subject matter by way of divisional application.

This election is made **with traverse**. Applicants respectfully submit that the Examiner's restriction requirement should be withdrawn. The field of search for the various configurations of the claims would be co-extensive. In addition, the various configurations are so interrelated that it would be in the public interest to allow applicants to prosecute all claims in the same application. This election of claims has been made merely to expedite the prosecution of the present application.

**Rejections Under 35 U.S.C. § 112**

In the Office Action mailed June 4, 2003, the Examiner rejected Claims 4 and 5 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 4 and 5 has been amended to provide antecedent basis for "heated air" and "air flow" respectively. Accordingly, Applicants believe the rejection should be withdrawn.

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**Rejections Under 35 U.S.C. § 103(a)**

The Examiner has failed to provide any suggestion or motivation to modify Elsberg with Jessup.

In the Office Action mailed June 4, 2003, the Examiner rejects claims 1, 3, 6-10, and 12-18 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,022,432 issued February 8, 2000 to Elsberg et al. (hereinafter "Elsberg") in view of U.S. Patent No. 5,669,996 issued September 23, 1997 to Jessup (hereinafter "Jessup"). This rejection is respectfully **traversed**.

Elsberg is directed to methods of making prefastened disposable absorbent articles which have side bonds and adjustable fastening systems. Jessup is directed to methods of joining an elastic material to a continuously moving, partially elastic substrate.

In order to establish a *prima facie* case of obviousness, three basic criteria must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP §2143.

Independent claims 1 and 10 of the present invention are directed to a process for making a prefastened and refastenable pant that includes, *inter alia*, the steps of providing an activatable retractive material in at least one of the waist regions and activating at least a portion of the retractive material causing the retractive material to retract.

The Examiner, on page 4 of the Office Action dated June 4, 2003, states that "Elsberg suggested that it was known at the time the invention was made to make a refastenable underpant," but acknowledges that Elsberg "fail[s] to make mention of the use of a retractable material in the waist region which was retracted subsequent to the activation of the retractable material." The Examiner attempts to remedy this deficiency in Elsberg by asserting that "Jessup suggested that those skilled in the art at the time the invention was made would have formed discrete articles as undergarments by folding over the discrete article in the crotch region, sealing the side edges and subsequently retracting the retractable material."

Applicants respectfully disagree.

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Initially, Applicants submit that the Examiner has provided no suggestion or motivation as to why one skilled in the art would modify Elsberg with Jessup as suggested by the Examiner. Moreover, The Examiner has failed to indicate how Elsberg or Jessup, alone or in combination, provide any suggestion for making the modification suggested by the Examiner. Indeed, while article of Elsberg may include waist elastic members, there is no indication in either Elsberg or Jessup as to why one of skill in the art would substitute the waist elastic of Elsberg with the waist elastic of Jessup. Moreover, Jessup, at Col. 4, lines 44 – 46, teaches away from such a combination, stating that the invention of Jessup relates to methods of joining an elastic material to a partially elastic substrate. Specifically, Jessup describes at Col 7, lines 52-62 a disposable absorbent garment 10 having a continuous waist border 30 that includes oppositely disposed elastic side segments 82, non-elastic front segment 84, and non-elastic back segment 86, thus disclosing an article with a partially elastic composite structure. As such, the method disclosed in Jessup provides the advantage of indicating how to apply an elastic material to a partially elastic composite structure so as not to substantially restrict or diminish the elasticity of that portion of the structure that is elastic, and can provide a desired elasticity to the non-elastic portion of the structure (See Jessup at Col. 8, lines 30-48). Thus, not only would one of skill in the art not be motivated to modify Elsberg with Jessup, Jessup teaches away from such a combination by being directed to the application of an elastic band to a partially elastic substrate.

Accordingly, Applicants assert that the Examiner is relying on the Applicants disclosure as a blueprint to reconstruct the claimed invention without any factual basis or suggestion as to why one skilled in the art would be motivated to do so. Such use of hindsight is improper (MPEP § 2145 (X)(A)), and as set forth in MPEP 2143, "the teaching or suggestion to make the claimed combination...must ...be found in the prior art, not in the applicant's disclosure." Accordingly, for at least the reasons set forth above, Applicants submit that the Examiner has not set forth a *prima facie* case of obviousness and therefore claims 1 and 10 are patentable over Elsberg in view of Jessup. Moreover, claims 3, 6-9 and 12-18 all eventually depend from independent claims 1 and 10; therefore, these claims are also accordingly patentable over Elsberg in view of Jessup.

Further, and with respect to claims 6 and 13, the Examiner believes that "[t]he compression of a retractable material is taken as conventional in the art of such retractable

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materials and it would have been within the purview of the ordinary artisan to employ such known retractable materials." Applicants respectfully disagree.

The criteria for a *prima facie* case of obviousness are set forth above. Claims 6 and 13 further recite that the process of the present invention may include "temporarily maintaining the retractive material in an extended and unstable state by application of a compaction force." The Examiner has failed to point out how Elsberg and Jessup, alone or in combination, teach or suggest this additional element, and instead makes an improper and unsupported assertion that the element "is conventional in the art." Such an unsupported assertion certainly does not meet the criteria for establishing a *prima facie* case of obviousness. Further, as set forth in MPEP 2144.03(E), "[i]t is never appropriate to rely only on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection [is] based."

Moreover, the Examiner has failed to provide any reason why one of ordinary skill in the art would further modify the teachings of Elsberg and Jessup to arrive at the inventions of claims 6 and 13. Instead, the Examiner's unsupported assertion that the claimed configuration "... would have been within the purview of the ordinary artisan...", presents only a conclusion, rather than a reason. As a result, the Examiner's grounds for rejection are improper and should be reversed. Ex parte William Garrett, Board of Patent Appeals and Interferences, slip opinion, September 30, 1986. Accordingly, for at least these additional reasons, applicants respectfully submit that claims 6 and 13 are patentable over Elsberg in view of Jessup.

Similarly, with respect to claims 7 – 9 and 16 – 18, directed to waistband-to-hip circumference ratio, the Examiner once again fails to indicate how Elsberg and Jessup, alone or in combination, teach or suggest the additional element of a waistband-to-hip circumference ratio. Instead the Examiner again improperly relies on an unsupported assertion to arrive at the claimed configuration ("...one skilled in the art would have determined the amount of retraction as a function of the desired fit...through routine experimentation."). Certainly, such an unsupported assertion does not meet the criteria required for establishing a *prima facie* case of obviousness as set forth above.

Moreover, the Examiner's unsupported assertion does not establish why one of skill in the art would be motivated to carry out the "routine experimentation" that the Examiner

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believes would allow one to arrive at the claimed invention. Instead, once again, the Examiner improperly presents only a conclusion rather than providing any motivation or suggestion. Accordingly, for at least these additional reasons, applicants respectfully submit that claims 7 – 9 and 16 – 18 are patentable over Elsberg in view of Jessup.

There is no motivation or suggestion to combine the teachings of Elsberg and Jessup and further in view of Roland or Thorson.

In the Office Action mailed June 4, 2003, the Examiner rejects claims 2, 4 – 5, and 11 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Elsberg in view of Jessup and further in view of U.S. Patent No. 4,665,306 issued May 12, 1987 to Roland et al. (hereinafter "Roland") or U.S. Patent No. 4,680,450 issued July 14, 1987 to Thorson et al. (hereinafter "Thorson"). This rejection is respectfully traversed.

The Examiner, on page 6 of the Office Action dated June 4, 2003, believes that the combination of Elsberg and Jessup does not "suggest the use of electromagnetic radiation application to the elastic material to heat the same and consequently shrink the same." Nonetheless, the Examiner believes that "[t]he reference to Roland suggested that as an alternative to application of heat to shrink the elastics those skilled in the art at the time the invention was made would have applied infrared radiation to the elastics...."

Claims 2 and 11 depend from independent claims 1 and 10 and are further recite that the step of activating the retractive material includes applying electromagnetic radiation. Claim 4 eventually depends from independent claim 1 and further recites that a greater volume of heated air is applied to a waistband as compared to a hip section. Claim 5 eventually depends from independent claim 1 and further recites that a higher temperature air flow is applied to a waistband as compared to a hip section. As discussed above with respect to claims 1 and 10, there is no motivation or suggestion to combine the teachings of Elsberg and Jessup to arrive at the presently claimed invention. Thus, for the reasons previously provided, there is no motivation or suggestion to combine Elsberg and Jessup with Roland or Thorson in order to arrive at the claims 2, 4-5, and 11 of the present invention. Accordingly, Applicants respectfully submit that claims 2, 4-5, and 11 are patentable over Elsberg in view of Jessup and further in view of Roland or Thorson.

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Further, and with respect to claims 4 and 5, applicants submit that the Examiner has failed to point out how either Roland or Thorson teach or suggest providing a comparatively differentiated heat application to a waistband and a hip section of an article. That is, the Examiner has failed to indicate how Roland or Thorson disclose the step of applying a greater volume of heated air to a waistband as compared to a hip section, or the step of applying a higher temperature air flow to a waistband as compared to a hip section. Therefore, for at least these additional reasons, claims 4 and 5 are patentable over Elsberg in view of Jessup and further in view of Roland or Thorson.

#### **Prior Art Made Of Record**

Applicants have reviewed the references cited by the Examiner but not relied upon in rejecting the claims. However, Applicants assert the cited references fail to teach or suggest the inventions recited in the rejected claims. Accordingly, the pending claims are patentable over such references.

#### **Information Disclosure Statements**

The Examiner's attention is drawn to the Supplemental Information Disclosure Statements that were submitted on October 10, 2002 and September 2, 2003. The Examiner is requested to make of record receipt and review of the documents listed therein.

In conclusion, and in view of the above amendments and remarks, reexamination, reconsideration and withdrawal of the rejections of claims 1 – 18 under 35 U.S.C. §§ 112 and 103 are respectfully requested. Moreover, it is respectfully submitted that all of the presently presented claims are in condition for allowance and such action is earnestly solicited. If the Examiner has any questions or if there are any remaining issues that can be handled by telephone, the Examiner is invited to contact the undersigned at (920) 721-3862.